

Remarks

Upon entry of the present amendment, claims 11, 12, 24-29, 36-40, and 46-50 are cancelled, and new claims 56-71 are added. Applicants reserve the right to pursue the subject matter encompassed by all canceled claims in one or more divisional or continuation application. Claims 51-52 are hereby amended to clarify the claimed subject matter. Claims 17, 19, 20, 30-35, 41-45, and 51-71 are hereby pending. Claims 17, 19, and 20 are withdrawn as allegedly drawn to a non-elected invention.

Support for new claims 56-71 can be found in the application as filed. More specifically, support for claims 56-58 can be found at, for instance, page 94, Table 1, row 12, page 98, line 24 to page 99, line 25, and page 113, lines 24-31. Support for new claims 59, 64, and 69 can be found, for instance, at page 110, line 5 to page 111, line 27. Support for new claims 60, 65, and 70 can be found at, for instance, page 176, line 28 to page 179, line 25 (Example 23). Support for new claims 61, 66, and 71 can be found at, for instance, page 111, line 29 to page 114, line 15. Support for new claims 62-63 can be found at, for instance, page 99, line 27 to page 107, line 2. Support for new claims 67-68 can be found at, for instance, page 107, line 4 to page 108, line 30.

The subject matter encompassed by new claims 56-71 is included in the search already conducted for claims 24-29. No new matter has been added by way of this amendment.

Restriction Requirement

Applicants would like to thank the Examiner for acknowledging the timely traversal of the Restriction Requirement of Paper No. 6. *See*, Paper No. 9, page 3, third paragraph. However, Applicants respectfully request clarification of the claims withdrawn by the Examiner as allegedly being drawn to a non-elected invention.

In the Restriction Requirement (Paper No. 6, mailed on 04/14/03), the Examiner requested that the invention be restricted to one of seven groups. Applicants responded to elect the invention of Group II (claims 11, 12, 14-16, and 20) and requested the rejoinder of the inventions of Group II (claims 11, 12, 14-16, and 20), Group IV (claim 17), and Group VI (claim 19), once the claims of Group II are found allowable. Additionally, in response to the Restriction Requirement, Applicants cancelled claims 1-10, 13-16, 18, and 21-23.

The present Office Action indicates that claims 17, 19, and 20 are withdrawn from consideration. *See*, Paper No. 9, page 1, item 4a. It also indicates that claims 17, 18, and 20 are withdrawn from further consideration. *See*, Paper No. 9, page 3, third paragraph (emphasis added). Applicants respectfully request clarification of the claims being withdrawn from further consideration as, according to the Restriction Requirement and Applicants' response to it, only claims 17 and 19 should be considered for withdrawal, not claim 18 and, particularly, not claim 20 (which belongs to elected Group II as cast by the Examiner; *see*, page 2 of Paper No. 6).

Furthermore, Applicants request the rejoinder of the inventions of Group II (claims 11, 12, 14-16, and 20), Group IV (claim 17), and Group VI (claim 19) once the claims of Group II are found allowable.

Claims Objection

Claims 11 and 12 are objected to for allegedly not reciting the elected invention. *See*, Paper No. 9, page 3, fourth paragraph.

Applicants respectfully point out that claims 11, and 12 have been canceled, hereby rendering the objection moot.

Rejection Under 35 U.S.C. § 112, second paragraph

Claims 11, 12, and 46-55 are rejected under 35 U.S.C. § 112, second paragraph as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. *See*, Paper No. 9, page 4, first paragraph. Specifically, the Examiner asserts:

Claims 11, and 12 are indefinite for the recitation of the phrase 'SEQ ID NO: Y or the encoded sequence included in ATCC Deposit NO: Z,' because it is unclear whether the ATCC Deposit NO: Z encodes the isolated polypeptide of SEQ ID NO: Y, or it is drawn to another encoded sequence.

See, Paper No. 9, page 4, second paragraph.

Preliminarily, Applicants respectfully point out that claims 11-12 and 46-47 have been cancelled, rendering their rejection under 35 U.S.C. § 112, second paragraph, moot. Applicants respectfully request that the rejection of claims 11-12 and 46-47 under 35 U.S.C. § 112, second paragraph be reconsidered and withdrawn.

Furthermore, the Office Action asserts "[c]laims 46-55 are indefinite for the recitation of the phrase, 'consisting of at least,' because it is unclear how many amino acid

sequences are considered to be within the phrase, 'consisting of at least,' versus 'comprising.' For the purpose of prosecution, the phrase is interpreted as meaning 'comprising at least.'" See, Paper No. 9, page 4, fourth paragraph.

Applicants have amended claims 51-52 in such a way as to further clarify the claimed invention. Applicants respectfully request that the rejection of claims 51-52 under 35 U.S.C. § 112, second paragraph be reconsidered and withdrawn.

Rejection Under 35 U.S.C. § 102(e)

Claims 11, 12, 24-55 are rejected under 35 U.S.C. § 102(e) for allegedly being anticipated by Baker et al. (US 2003/0073129 A1, published April 17, 2003, priority September 1, 1998) (later referred to as "Baker"). See, Paper No. 9, page 5, first paragraph.

Applicants respectfully disagree.

Preliminarily, Applicants respectfully point out that claims 11, 12, 24-29, 36-40, and 46-50 have been cancelled, rendering their rejection under 35 U.S.C. § 102(e), moot. Applicants respectfully request that the rejection of claims 11, 12, 24-29, 36-40, and 46-50 under 35 U.S.C. § 102(e) be reconsidered and withdrawn.

Applicants respectfully submit that claims 30-35, 41-45, 51-55, and new claims 56-71 properly claim priority back to the earliest filed provisional application to which the present application claims priority, namely, U.S. Provisional Application No. 60/074,157, filed on February 9, 1998 (later referred to as "157"). In Table 1, at page 45, row 10, of the '157 application, clone HHEPU32 is described by its nucleotide sequence SEQ ID NO: 9; corresponding amino acid sequence SEQ ID NO: 19; and corresponding ATCC Deposit No: 209603, deposited on January 29, 1998. In the corresponding International Application PCT/US99/02293, filed on February 9, 1999, that same HHEPU32 clone is identified as Gene No. 38, corresponding to nucleotide sequence SEQ ID NO: 48, amino acid sequence SEQ ID NO: 97; and the same ATCC Deposit No: 209603, deposited on January 29, 1998. See, Table 1, page 81, row 4.

In the present application, that same HHEPU32 clone is identified as Gene No. 38, corresponding to nucleotide sequences SEQ ID NOS: 48 and 59, amino acid sequences SEQ ID NOS: 97 and 108; and the same ATCC Deposit No: 209603, deposited on January 29, 1998. See, Table 1, page 94, rows 11 and 12.

Furthermore, Applicants respectfully assert that newly claimed SEQ ID NO: 108 is

the same sequence as disclosed in the corresponding International Application PCT/US99/02293 as SEQ ID NO: 97, which in turn is the same sequence as disclosed in U.S. Provisional Application No. 60/074,157 as SEQ ID NO: 19.

Therefore, Applicants assert that the present claimed amino acid SEQ ID NO: 108 corresponds to clone HHEPU32, which relies on the same cDNA sequence contained in ATCC Deposit No. 209603, deposited on January 29, 1998, *i.e.*, before the earliest priority date of Baker (September 1, 1998).

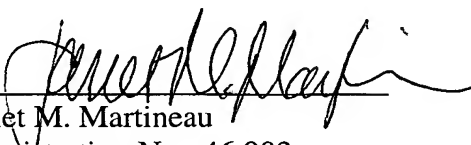
Therefore, because Applicants had possession of the HHEPU32 cDNA sequence corresponding to the present claimed amino acid sequence SEQ ID NO: 108 at the time the provisional application, to which the present application claims priority, was filed, the Baker reference does not constitute prior art and claims 30-35, 41-45, 51-55, and new claims 56-71 are not anticipated. Additionally, Applicants have amended claims 51-52 and respectfully request that the rejection of claims 30-35, 41-45, 51-55 under 35 U.S.C. § 102(e) be reconsidered and withdrawn.

Conclusion

The Examiner is invited to call the undersigned at the phone number provided below if any further action by Applicant would expedite the examination of this application. If there are any fees due in connection with the filing of this paper, please charge the fees to our Deposit Account No. 08-3425.

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Respectfully submitted,

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